

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* SUSAN H. MATTHEWS



Appeal No. 2003-1647  
Application 09/679,139

ON BRIEF

Before PAK, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*REMAND TO THE EXAMINER*

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.196(a) (2003); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 1, Feb 2003; 1200-29 – 1200-30).

The record shows that claims 7, 8, 10 and 16 were separately finally rejected over different combinations of references than finally rejected claims 1 through 3, 5, 6, 9, 11, 12, 14, 15 and 17 through 22 in the Office action of May 22, 2002 (Paper No. 9). The rejections were maintained in the advisory action of August 22, 2002 (Paper No. 11).

In the brief, appellant states that “[c]laims 1-3, 5-12 and 14-22 are rejected and are the subject of this appeal” (page 2). In stating the issue and in argument, appellant acknowledges only the ground of rejection of claims 1 through 3, 5, 6, 9, 11, 12, 14, 15 and 17 through 22.

Indeed, there is no other mention of appealed claims 7, 8, 16 and 19 in the brief after page 2.

In the answer, the examiner notes appellant's omission, stating that “[s]ince claims 7-8, 10 and 16 have not been addressed as an issue nor are they argued separately, they are deemed to stand and fall with claims 1-3, 5-6, 9, 11, 12, 14, 15 and 1-22” (page 2). The examiner sets forth in the answer only the statement of the ground of rejection applying to claims 1 through 3, 5, 6, 9, 11, 12, 14, 15 and 17 through 22, without supporting reasoning, citing no prior Office action in which such reasoning is found.

It is clear from 37 CFR § 1.192(d) (2002) that appellant is to be notified by the examiner whenever the brief does not comply with any of the requirements of 37 CFR § 1.192(c), and especially where appellant has failed to respond to a ground or grounds of rejection, in order to avoid dismissal of the appeal with respect to the claim(s) subject to the ground(s) of rejection, which carries with it loss of the claim(s), for inadvertent non-compliance with the rule by appellant. MPEP §§ 1206 and 1215.04 (8th ed., Rev. 1, Feb 2003; 1200-8 – 1200-09 and 1200-12; 1200-40 – 1200-41).

Furthermore, it is also clear from MPEP § 1208 (8th ed., Rev. 1, Feb 2003; 1200-17) that the ground of rejection including supporting reasoning may be incorporated into the answer by reference to a single prior Office action.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to notify appellant of non-compliance with the requirements of 37 CFR § 1.192(c) in the failure to address the two grounds of rejection, and to state in a supplemental answer all of the grounds of rejection advanced on appeal and either include a statement of each ground of rejection in the supplemental Office action or incorporate the statement of each ground of rejection by reference to a single prior Office action, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 1, Feb 2003; 700-121). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.*, MPEP § 1211 (8th ed., Rev. 1, Feb 2003; 1200-30).

*Remanded*



CHUNG K. PAK

Administrative Patent Judge

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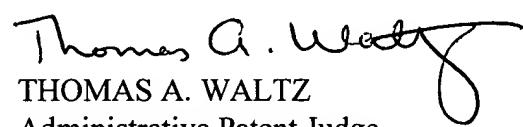
CHARLES F. WARREN

Administrative Patent Judge

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THOMAS A. WALTZ

Administrative Patent Judge

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Townsend and Townsend and Crew, LLP  
Two Embarcadero Center  
Eight Floor  
San Francisco, CA 94111-3834